

REMARKS/ARGUMENTS

In response to the Notice of Non-Compliant Amendment, claims 1-8, 15-23, 28 and 30 have been corrected to indicate that these claims have been cancelled in compliance with 37 CFR 1.121(c). Applicants believe that the Amendment is now in compliance and, as such, Applicant's desire the Examiner to withdraw the Notice of Non-Compliant Amendment.

Status of the Claims

Claims 9-14, 24-27, and 29 are currently pending in the application. No claims have been amended, added, or cancelled. Therefore, claims 9-14, 24-27, and 29 are present for examination. Claims 9, 15, 22, 24, and 28-30 are independent claims.

Prior to entry of this amendment, the application included claims 9-14, 24-27, and 29. A non-final office action mailed March 10, 2008, has rejected claims 9-14, 24-27, and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publ. No. 2005/0080738 A1 to Sellen et al. ("**Sellen**") in view of U.S. Patent No. 5,878,141 issued to Daly et al. ("**Daly**"). Claims 11 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellen in view of Daly and further in view of Official Notice. Claims 13-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellen in view of Daly and further in view of U.S. Patent No. 6,957,770 B1 issued to Robinson ("**Robinson**").

35 U.S.C. §103 Rejection, Sellen et al. in view of Daly et al.

Claims 9-10, 12, 24-25, 27 and 29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publ. No. 2005/0080738 A1 to Sellen in view of Daly. Applicants respectfully request reconsideration of the rejection because the Examiner has failed to show a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, *the prior art reference (or*

Appl. No. 10/730,859
Amdt. dated September 19, 2008
Reply to Office Action of March 10, 2008 and further in
response to the Notice of Non-Compliant Amendment
mailed September 9, 2008

PATENT

references when combined) must teach or suggest all the claim limitations.
MPEP §2142, Original Eighth Edition, August, 2001, Latest Revision August
2006 (*emphasis added*).

Examiner relies on Sellen to show one or more of the limitations of the claims.
However, reliance on Sellen for this obviousness rejection is improper.

Sellen is prior art only under 35 U.S.C. § 102(e), which states:

A person shall be entitled to a patent unless — . . .

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent. . . .

Sellen is not prior art under any of one or more sections of 35 U.S.C. § 102.

Per 35 U.S.C. § 103(c), a reference which is prior art under 35 U.S.C. § 102(e) cannot be used in an obviousness rejection under 35 U.S.C. § 103, if that reference was owned by the same person or subject to an obligation of assignment to the same person. The pertinent section of 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Both Sellen and the present application were either owned or under an obligation of assignment to First Data Corporation. Examiner may reference Reel/Frame Number 014975/0208 to view the assignment recordation of Sellen. Likewise, Examiner can refer to Reel/Frame Number 014972/0840 to view the assignment recordation of the present application. Therefore, 35 U.S.C. § 103(c) precludes the use of Sellen as a reference in an obviousness rejection.

Without Sellen, the Examiner has failed to show that all of the elements of independent claims are present in the cited art. Therefore, the Examiner has failed to prove a *prima facie* case for obviousness. The claims are allowable over the cited art.

35 U.S.C. §103 Rejection, Sellen et al. in view of Daly et al. and further in view of Official Notice

Claims 11 and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellen in view of Daly and further in view of Official Notice. As per the explanation above, 35 U.S.C. § 103(c) precludes the use of Sellen as a reference in an obviousness rejection. Without Sellen, the Examiner has failed to show that all of the elements of the independent claims are present in the cited art. Therefore, the Examiner has failed to prove a *prima facie* case for obviousness. The claims are allowable over the cited art.

Further, Applicants would also like to object to the Examiner taking Official Notice. Applicants request, per MPEP § 2144.03, that the Examiner explain reasons why each of the elements listed would have been known in the art at the time of the invention. At present, the Examiner has only stated that attributing the geographical location to a state would have been known. However, this explanation ignores the other possibilities listed in the claims. Therefore, the Examiner's use of Official Notice is improper in this instance.

35 U.S.C. §103 Rejection, Sellen et al. in view of Daly et al. and further in view of Robinson

Claims 13-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Sellen in view of Daly and further in view of U.S. Patent No. 6,957,770 B1 issued to Robinson ("**Robinson**"). As per the explanation above, 35 U.S.C. § 103(c) precludes the use of Sellen as a reference in an obviousness rejection. Without Sellen, the Examiner has failed to show that all of the elements of independent claims are present in the cited art. Therefore, the Examiner has failed to prove a *prima facie* case for obviousness. The claims are allowable over the cited art.

Appl. No. 10/730,859
Amdt. dated September 19, 2008
Reply to Office Action of March 10, 2008 and further in
response to the Notice of Non-Compliant Amendment
mailed September 9, 2008

PATENT

Double Patenting Rejection

Claims 9-14, 24-27, and 29 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/731,212. A terminal disclaimer is provided herewith. As such, this rejection is now moot.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any argument not specifically addressed herein. Rather, Applicants believe the amendments and arguments contained herein overcome all rejections presented.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Tadd F. Wilson
Reg. No. 54,544

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
T3W:slb

61509718 v1